



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,511	08/19/2003	Ron Rosansky	15799-2	5466

7590 12/14/2005

Michael B. Johannesen, Esq.
Lowenstein Sandler, P.C.
65 Livingston Avenue
Roseland, NY 07068

EXAMINER

DESIR, PIERRE LOUIS

ART UNIT	PAPER NUMBER
----------	--------------

2681

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,511	Applicant(s) ROSANSKY, RON	
	Examiner Pierre-Louis Desir	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-11, and 13-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 13 and 19, the limitation “said call record, said client information, said matter information, or said combination of both,” renders the claim indefinite because it is unclear which two of the “said call record, said client information, said matter information” are covered in the combination. Appropriate correction is required.

Note: for the process of examination, Examiner will interpret “combination of both” as the combination of “said client information and said matter information.”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2681

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-10, 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Beckanich, Pub. No. 2005/0043065.

Regarding claim 1, Beckanich discloses a method for capturing information related to usage of a wireless handheld device and attributing said usage to one of a plurality of matters (see abstract), the method comprising: receiving entry of at least one matter (i.e., displaying a call event on the screen of the device) (see figs. 1, 4-7, and page 2, paragraph 20); detecting and timing said usage (i.e., detecting a call event, and provide monitoring information indicative of the call time length) (see figs. 1, 4-7, and page 2, paragraph 20); capturing call record information related to said usage in memory of the wireless handheld device (see figs. 1, 4-7, and paragraphs 20 and 30); attributing the at least one matter to said usage of the wireless handheld device (see figs. 1, 4-7, and page 3, paragraph 30); and transmitting captured call record information and said timing of said usage from said wireless handheld device to a database so that costs for said usage are attributable to at least one matter, wherein the at least one matter relates to capturing professional services time related to communication with or on behalf of at least one client (i.e., the information is then provided to a server that contains related billing software to generate a bill for the contact) (see abstract and paragraph 26).

Regarding claim 2, Beckanich discloses a method (see claim 1 rejection) wherein said wireless handheld device provides voice communication and wherein detecting and timing said usage further comprise detecting an outgoing call and timing said outgoing call (see page 2, and paragraph 20).

Regarding claim 3, Beckanich discloses a method (see claim 1 rejection) wherein said wireless handheld device provides voice communication and wherein detecting and timing said usage further comprise detecting an incoming call and timing said incoming call (see page 2, and paragraph 20).

Regarding claim 4, Beckanich discloses a method (see claim 1 rejection) wherein said receiving entry of the at least one matter further comprises prompting for the at least one matter prior to usage (see page 3, paragraph 32).

Regarding claim 5, Beckanich discloses a method (see claim 1 rejection) wherein said receiving entry of the at least one matter further comprises prompting for the at least one matter after usage (i.e., displaying call event information during and after usage).

Regarding claim 6, Beckanich discloses a method (see claim 1 rejection) wherein said receiving entry of the at least one matter further comprises receiving an alphanumeric string that identifies the at least one matter (see figs. 1, 7, and paragraphs 30, 55, and 60).

Regarding claim 7, Beckanich discloses a method (see claim 1 rejection) wherein said receiving entry of the at least one matter further comprises receiving verbally the at least one matter (i.e., voice alert) (see page 2, paragraph 25).

Regarding claim 8, Beckanich discloses a method (see claim 1 rejection) wherein said receiving entry of the at least one matter further comprises receiving manually the at least one matter (i.e., keypad 18 is used by an operator to input commands to CPU) (see page 4, paragraph 56, and page 5, claim 12).

Regarding claim 9, Beckanich discloses a method (see claim 1 rejection) wherein transmitting the call record information and said usage timing further comprises sending a data message (i.e., SMS or text message) (see page 5, claim 12).

Regarding claim 10, Beckanich discloses a method (see claim 1 rejection) further comprising using said captured call record information and said timing or said usage is for generating professional services records (see abstract).

Regarding claim 13, Beckanich discloses a wireless handheld communication device (see abstract) comprising: a timer configured to time wireless communication (i.e., clock 19) (see fig. 2, and paragraph 56); an input device to receive call record information comprising client information, matter information, or a combination of both from a user related to wireless communication (i.e., display 16) (see figs. 1-2, paragraphs 13-14, and 55-56); storage configured to store call record information and timing information from said timer related to at least one call (see paragraph 7); a communications system to transmit said call record, said client information, said matter information, or said combination of both relates to capturing professional services time relating to communication with or on behalf of at least one client (see paragraph 13).

Regarding claim 14, Beckanich discloses a device (see claim 13 rejection) wherein said input device comprises means for prompting said user to enter said client information, said matter information, or said combination of both (see paragraph 19).

Regarding claim 15, Beckanich discloses a device (see claim 13 rejection) further including a voice communication system (i.e., voice data, voice call event) (see paragraphs 7 and 56), wherein said timer is configured to time one or more calls through said voice communication system (call time monitoring) (see paragraph 7) and said input device is

Art Unit: 2681

configured to receive verbally said client information, said matter information, or said combination or both related to the at least one call (see paragraph 12).

Regarding claim 16, Bekanich discloses a device (see claim 15 rejection) wherein a voice communication system (see page 6, paragraph 86) is configured to make one or more calls in response to receiving said client information, said matter information, or said combination of both being entered (i.e., dialing a call) (see fig. 7, and paragraphs 19, 56, and 60).

Regarding claim 17, Bekanich discloses a device (see claim 15 rejection) wherein a voice communication system is configured to prompt for said client information, said matter information, or said combination of both in response to an incoming or outgoing call (see paragraph 19).

Regarding claim 18, Beckanich discloses a system for capturing information related to usage of a wireless handheld device (see abstract) comprising: a database system (i.e., server) storing information related to a plurality of clients and matters wherein the database system is configured to communicate with said wireless handheld device and to said usage of said wireless handheld device to at least one of said plurality of clients and matters wherein the information related to at least one of said plurality of clients and matters relates to capturing professional services time relating to communication with or on behalf of at least one client (see abstract, and paragraphs 7 and 13); and a wireless handheld device (see fig. 1) configured for wireless communication (see abstract and page 1, paragraph 7) and for automatically transmitting the information related to at least one of said wireless handheld device to said database system (see paragraphs 7 and 13), and further configured for attributing the at least one of said plurality of

clients and matter to said usage (i.e., providing monitoring information indicative of the call time length relating to billable timed call event of an existing person or persons) (see paragraph 7).

Regarding claim 19, Beckanich discloses a device (see claim 13 rejection) further comprising display to display information to the user (see fig. 1) wherein the information comprises said call record, said client information, said matter information, or a combination of both (i.e., displaying a call event) (see fig. 1, abstract, and paragraph 7).

Regarding claim 20, Beckanich discloses a method (see claim 1 rejection) further comprising storing said captured call record information in a list in said wireless handheld device (i.e., call event information of existing person or persons stored internally in the wireless device) (see fig. 1, paragraph 20).

Regarding claim 21, Beckanich discloses a method (see claim 20 rejection) further comprising accessing said list in order to attribute the at least one matter to said captured call record information after completion of an incoming or outgoing call (i.e., future modification of the stored or captured call event in the database) (see paragraph 20).

Regarding claim 22, Beckanich discloses a method for capturing information related to usage of a wireless handheld device and attributing said usage to one of a plurality of matters (see abstract), the method comprising: receiving entry of at least one matter (i.e., displaying a call event on the screen of the device) (see figs. 1, 4-7, and page 2, paragraph 20); detecting and timing said usage (i.e., detecting a call event, and provide monitoring information indicative of the call time length) (see figs. 1, 4-7, and page 2, paragraph 20); capturing a usage record related to said usage in memory of the wireless handheld device (see figs. 1, 4-7, and paragraphs 20 and 30); storing said usage record in a list in said wireless handheld device (see fig. 1, paragraph 20);

attributing the at least one matter to said usage of the wireless handheld device (see figs. 1, 4-7, and page 3, paragraph 30); and transmitting captured call record information and said timing of said usage from said wireless handheld device to a database so that costs for said usage are attributable to at least one matter, wherein the at least one matter relates to capturing professional services time related to communication with or on behalf of at least one client (i.e., the information is then provided to a server that contains related billing software to generate a bill for the contact) (see abstract and paragraph 26).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beckanich (Beckanich 1), Pub. No. 2005/0043065, in view of Bekanich (Beckanich 2), (Pub. No. 2004/0209595).

Regarding claim 11, Beckanich discloses a method as described above (see claim 1 rejection).

Although Beckanich 1 discloses a method as described, Beckanich 1 does not specifically disclose a method wherein detecting usage further comprises detecting beginning an email process.

However, Beckanich 2 discloses a method comprising wherein detecting airtime usage comprises detecting opening an email process (see fig. 14B, page 7 and paragraph 94).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Beckanich 2 with the teachings of Beckanich 1 to arrive at the claimed invention. A motivation for doing so would have been to ensure the accuracy of the billing process.

Regarding claim 23, Beckanich 1 discloses a method as described above (see claim 22 rejection).

Although Beckanich 1 discloses a method further comprising accessing said list to attribute the at least one matter to said usage record after the completion of an incoming or outgoing call event (see paragraph 20), Beckanich does not specifically disclose that the call event is an email process (after completion of an email process).

However, Beckanich 2 discloses a method comprising wherein detecting airtime usage comprises detecting opening an email process (see fig. 14B, page 7 and paragraph 94).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Beckanich 2 with the teachings of Beckanich 1 to arrive at the claimed invention. A motivation for doing so would have been to ensure the accuracy of the billing process.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre-Louis Desir
AU 2681
12/04/2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER